Attorney Docket No. 15737US01

REMARKS

The present application includes claims 106-123. Claims 106-122 have been rejected by the Examiner. By this response, claims 106, 107, 110, 111, 117, 119 and 121 have been amended. New claim 123 has been added. Claim 113 has been canceled.

The Examiner has rejected pending claims 106-122 of the present application as unpatentable over Luciano (U.S. Patent Number 6,050,895) in view of Torango (U.S. Patent Number 6,592,460). However, at least three primary differences distinguish the pending claims from Luciano, Torango, and any hypothetical combination of Luciano and Torango.

Claim 106

First, neither Luciano nor Torango teaches or suggests the step of "randomly selecting said one progressive prize from said plurality of progressive prizes that has been won."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

Attorney Docket No. 15737US01

prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

In Luciano, there is no description or suggestion of a plurality of progressive prizes, let alone a suggestion of randomly selecting which one of a plurality of progressive prizes has been won. (Luciano, col. 6, lns. 42-44). In Torango, one and only one progressive prize must be played for. Torango can only play for one prize because the odds of the awarding of the progressive prize are based on the total wager amount which is associated with the particular prize played for. (Torango, col. 16, lns. 9-30).

In Torango, the one prize to be played for, is selected by the player in advance of playing the game. (Torango, col. 15, ln. 66 – col. 16, ln. 7). Thus, only one prize is played for. The reason for this is because the "odds" of winning a prize in Torango are calculated using the total wager amount for that particular prize. A player cannot play for a prize until the player has selected which prize to play for, and the odds are then calculated using the following equation: $MR = PT/WG$. (Torango, Col. 16, ln. 15). MR is the maximum number of the range of the random number selection. This range is thus based on PT. PT is a prize's total wager amount "which is the sum of all wagers made over the theoretical number of handle pulls, or plays, of a game between the prize award events." (Torango, col. 8, lns. 16 – 18). PT is determined for the prize amount being played for. Thus, MR equals the theoretical number of handle pulls between wins, and thus equals the "odds."

Torango confirms that a player must play for **one prize** by stating "...the Free Play apparatus may also contain a selection button 605 (FIG. 6) to enable the player to select from a menu of different progressive prizes 702. ... As soon as play is detected on

Attorney Docket No. 15737US01

the gaming device, *the currently selected prize is the one being played for.*" (Torango, col. 15, ln. 66 – col. 16, ln. 7). Torango does not teach randomly selecting which one of a plurality of progressive prizes has been won, but rather teaches player selection of the progressive prize in advance of play.

Second, neither Luciano nor Torango teaches or suggests that a second game is used to determine the one progressive prize that is randomly selected from a plurality of progressive prizes. Luciano does not determine which one of a plurality of progressive prizes has been won, let alone that it is a second game which does the random selection from among a plurality of progressive prizes. Nor does Torango teach or suggest that it is a second game that determines the prize. Torango's free play apparatus merely determines whether one progressive prize has been won, and that particular prize being played for is determined by the player and not by a second game. In Torango, the player chooses the prize played for, whereas in claim 106, a second game is used to determine the prize.

Third, Luciano does not teach or suggest that the second game appears after the completion of the first main game. Instead, Luciano's second game occurs during play of the skill based first game of Luciano (Luciano, col. 10, lns. 47-55). Torango does not teach or suggest display of a second game, let alone the time of the display.

Since neither Luciano nor Torango disclose these three limitations, their hypothetical combination could not disclose them either. For example, if Torango were to be combined with Luciano, Luciano's second game would not occur at the completion of the first main game. Further, Luciano's second game would not randomly select which one of a plurality of progressive prizes has been won.

Attorney Docket No. 15737US01

In the Office Action of September 15, 2005, the Examiner addresses a fourth limitation, i.e., that of determining the probability of a trigger condition based on the amount of the wager. The Examiner states that Luciano does <u>not</u> explicitly disclose this limitation; however, the Examiner believes that Luciano and Torango somehow meet this fourth limitation. While Applicant disagrees, the discussion above demonstrates that Luciano alone or in combination with Torango fails to meet at least three claim limitations.[1]

Claim 107

The Examiner states that "Torango discloses ... creating a set of numbers based on the amount of wager." This, however, refers to the range of the random number generator from which a single number is generated (Torango, col. 16, lines 41-43). However, that set of numbers is not the allotted numbers claimed in part (2) of claim 107. The language of part (2) of claim 107 is "allotting a plurality of numbers from the predetermined range of numbers in proportion to the amount of the wager" which refers not to creating the set of numbers for the predetermined range of numbers, but refers to allotted numbers against which a selected random number is compared.

In contrast, Torango's Free Play apparatus generates a random number which is compared to only one number, and it is a predefined number, the number "1" (Torango, col. 16, lines 43-45). Neither Torango nor Luciano disclose allotting a plurality of numbers against which a generated random number is compared.

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[1] THE EXAMINER CITES TO TORANGO COL. 24, LINES 8-10 WHICH LANGUAGE IS <u>NOT</u> PRIOR ART TO THIS APPLICATION SINCE IT IS LANGUAGE OF CLAIMS FILED AFTER THE PRIORITY DATE OF THIS APPLICATION.

Attorney Docket No. 15737US01

Nor, would it have been obvious in view of Torango or Luciano to allot a plurality of numbers for comparison with the generated random number. Torango discloses computing the range of numbers for the random number generator, i.e., computing the maximum number of that range ("MR") (Torango, col. 16, lns. 8-14). To allot a plurality of numbers in Torango (against which the random number is compared) would affect the "odds" which have been purposely and previously defined before the random number is generated. This is counter-productive since to allot a plurality of numbers interferes with the odds computation performed by Torango.

Claim 110

At the November 15 interview, the Examiner directed applicant specifically to Claim 110. Claim 110 has been amended to an independent form including the limitations of claims 107 and 106, as those claims are herein amended.

Claim 110 further defines the step of causing a second game trigger condition to include "allotting a plurality of numbers ... in proportion to the amount of the wager made" and wherein one number is allotted for "each unit of currency of the amount wagered."

Neither Torango nor Luciano discloses allotting a plurality of numbers, let alone that one number is allotted for each unit of currency wagered. Further, there is no reason or basis in Luciano or Torango to allot one number for each unit of currency of the amount wagered.

In contrast, Torango's Free Play apparatus generates a random number which is compared to only one number, and it is a predefined number, the number "1" (Torango,

Attorney Docket No. 15737US01

col. 16, lines 43-45). Neither Torango nor Luciano disclose allotting a plurality of numbers to determine occurrence of a trigger condition.

Claim 111

Claim 111 defines the initialization of the random number generator at start up (application, page 7, lines 22 – 25) and prior to playing said first main game (application, flow chart in Figure 2, blocks 20, 21). For every game that is played (application, page 7, line 26), a random number from the predetermined range is selected.

Claim 111 would not have been obvious to one of ordinary skill in the art in light of Torango. First, initializing the range of numbers at start up to a fixed range is neither taught nor suggested by Torango's Free Play apparatus. In Torango, the range of numbers is computed during play, and the range of numbers is intended to change as Total Wager Amount changes with currency exchange rate fluctuations. In Torango, "[p]lay is executed by determining the value of the wager, then creating a set of numbers for the random number generator using this equation: MR=PT/WG." (col. 16, lines 11-13). PT is the prize's total wager amount which fluctuates with currency exchange rates. In Torango, the range of numbers is purposefully not fixed and is not predetermined so that currency fluctuations adjust the range of the random number generator to equalize the odds between different currencies. If the range of numbers in Torango were fixed, then the variable "MR" would become a constant in the range/odds equation (col. 16, lines 16-18). However, the purpose of Torango is to allow fluctuation in currency exchange rates to adjust the odds of the gaming machine. Thus, the Total Wager Amount (PT in the equation at col. 16, lines 16-18) must change.

Attorney Docket No. 15737US01

Thus, it would not have been obvious in view of Torango to initialize the range of numbers at start up to a predetermined fixed range for the random number generator from which on every play, a number is selected.

Claim 117

Claim 117 recites the step of triggering to include awarding more than one game (application, page 12, lines 15, 16). Neither Luciano nor Torango discloses a third game or more games. It would not have been obvious in view of Luciano or Torango to add two or even more than two games to a triggering step. There is simply no suggestion to do so.

Claim 121

Claim 121 claims that the second game has a higher probability of winning than the first main game. Neither Luciano nor Torango suggest the winning probability of a second game relative to a first game.

Claim 123

Claim 123 is a new claim and serves to differentiate over claim 106. Claim 106 is broader than claim 123. Claim 106 covers the method where the one progressive prize is selected prior to the display of the second game, but not revealed to the player until play of the second game.

Attorney Docket No. 15737US01

Official Notice

The Examiner has made several statements which could be interpreted as the Examiner asserting Official Notice of the subject of the statements. For example, in relation to claims 109-110, the Examiner states that "allotting one number for each bet credit of currency would have been an obvious design choice." Additionally, in relation to claims 113-116, the Examiner states that "the limitations stated in claims 113-121 [sic] would have been well known to a person of ordinary skill in the art at the time the invention was made." In relation to claims 117-122, the Examiner states that "awarding more than one game as the bonus game, using currency denomination in cents, providing unequal progressive prize values, providing prizes as a fraction of a pool, providing a second game with higher probability of success than the main game, and alerting occurring of the second game prior displaying the second game would have been both well known and obvious design choice."

If the Examiner is asserting Official Notice that the subjects of these statements are common knowledge, the Applicant respectfully traverses the Examiner's assertions. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner.

In addition, the Applicant respectfully submits that the Examiner's assertions are not well known in the art as evidenced by the searched and cited prior art. The Applicants respectfully submit that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02. The Applicant respectfully submits that the cited references found

Attorney Docket No. 15737US01

during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art.

However, in the Examiner's thorough and detailed search of the relevant prior art, none of the applied prior art teaches or suggests the subject matter of the Examiner's assertions of Official Notice. The Applicant respectfully submits that if the subject matter of the Examiner's assertions of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior art does not teach or suggest the subject matter of the Examiner's assertions of Official Notice and respectfully traverse the Examiner's assertions of Official Notice.

Allowance of claims 106-123 is respectfully requested.
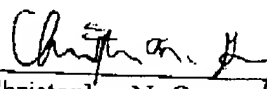
Attorney Docket No. 15737US01

CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

Date: December 6, 2005

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17 of 17̶1̶7̶

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